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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Toru Ozaki

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EXAMINER

GART, MATTHEW S

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

07/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/933,766

Applicant(s)

OZAKI ET AL.

Examiner

Matthew S. Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 10-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 28-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/21/2007 has been entered.

Prosecution History Summary

- Claims 1-29 are pending in the instant application.
- Claims 10-27 were previously withdrawn.
- Claims 1-9 and 28-29 are rejected as set forth below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-9 and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Sahota (Patent Application Publication No. 2002/0010928 A1).

Referring to claim 1. Sahota discloses a commerce information managing method for managing commerce information, comprising:

- Receiving a request to generate a commercial message broadcast and commercial message information relating to the commercial message broadcast from at least one of a merchandise producer and a service provider (Sahota: paragraph 0062, "The method and system provide an end-to-end framework for network operators and broadcasters to integrate seamlessly existing assets to generate new interactive advertising services.");
- Requesting a concurrent broadcast of the commercial message broadcast (Sahota: Fig. 1A, "TV Commercial 108") and the commercial message information relating to the commercial message broadcast generated according to the commerce information (Sahota: Fig. 1A, "Internet Advertising Content 112"), during a broadcast of a main program (Sahota: paragraph 0017, "In such a

system, broadcasters or content providers can target specific users with interactive content (e.g., an advertisement banner) integrated with specific TV commercial content."); and

- Receiving at a broadcast reception terminal device of a client, as part of the commerce information, commercial message broadcast designation information contained in the commercial message information and designating at least the commercial message broadcast when the client sees the commercial message broadcast (Sahota: paragraph 0060), performs an instruction for displaying the commercial message information relating to the commercial message broadcast and purchases merchandise or a service in the commercial message information relating to the commercial message broadcast (Sahota: paragraph 0061).

Referring to claim 2. Sahota further discloses a method wherein said commercial message information contains at least one of a merchandise catalog, a merchandise guide book in which merchandise is classified based on a characteristic of each piece of merchandise (Sahota: paragraph 0043, "For example, advertising server **230** can store specific rules, which specify the personalization of content for a particular user, i.e., providing a local restaurant advertisement content with a local TV commercial for the restaurant.").

Referring to claim 3. Sahota further discloses a method wherein said commercial message information is described in an XML data format; and specific information

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contained in the commercial message information is distributed (Sahota: paragraph 0036).

Referring to claim 6. Sahota further discloses a method comprising analyzing data of the commerce information being managed; and transmitting an analysis result to the merchandise producer of the service provider (Sahota: paragraph 0041).

Referring to claim 7. Sahota further discloses a method wherein said commerce information contains any of information relating to merchandise or a service, attribute data of the client, and information about merchandise or a service purchased by the client (Sahota: paragraph 0036 and paragraph 0041).

Referring to claim 8. Sahota further discloses a method comprising distributing instructions about merchandise or a service generated by the merchandise producer or the service provider to a shop at which a client receives merchandise or a service so that the client can receive a support of aftercare for the merchandise or the service (Sahota: Fig. 5B, "Help").

Referring to claim 9. Sahota further discloses a method comprising assigning the client a service point based on the CM broadcast designation information, information about merchandise or a service purchased by the client, and attribute data of the client (Sahota: Fig. 5B, "Help").

Referring to claim 28. The limitations of claim 28 closely parallel those of claims 1-3 and 6-9. Claim 28 is rejected under the same rationale as set forth above in claims 1-3 and 6-9.

Referring to claim 29. The limitations of claim 29 closely parallel those of claims 1-3 and 6-9. Claim 29 is rejected under the same rationale as set forth above in claims 1-3 and 6-9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sahota (Patent Application Publication No. 2002/0010928 A1) in view of Mayer (U.S. Patent No. 5,774,534).

Referring to claim 4. Sahota teaches a method according to claim 1 as indicated supra. Sahota does not specifically teach a method wherein a broadcast program for broadcasting the commercial message broadcast and the commercial message information relating to the commercial message broadcast is bought from the broadcasting station. Mayer teaches a method, wherein a broadcast program for broadcasting the commercial message broadcast and the commercial message information relating to the commercial message broadcast is bought from the broadcasting station (Mayer: column 15, lines 61-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Sahota to have included the teachings of Mayer in order to provide a seamless integration of existing assets to generate new interactive commercial advertising services (Sahota: paragraph 0005).

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Referring to claim 5. Sahota in view of Mayer discloses a method according to claim 4 as indicated supra. Sahota further discloses a method wherein said broadcast program is changed based on at least one of merchandise inventory information about the merchandise producer and service providing information about the service provider (Sahota: paragraph 0042).

Response to Arguments

Applicant's arguments filed 11/24/2006 have been considered but are not persuasive.

The Applicant argues that Sahota does not suggest, "...Commercial message broadcast designation information." The Applicant further argues that no suggestion has been found in Sahota that the web site address designates the commercial message in any way.

The Examiner notes, at operation **445** (Sahota: paragraph 0061), a user of TV **104** can launch interactive services by accessing interactive content **510**. For example, a user accessing interactive content **510** will begin interacting with a website as shown in FIG. 5B related to the clothing retailer. The website is designated based on the commercial message. Sahota's main focus is a method and system for integrating Internet advertising with television commercials. This integration would not be possible without commercial message broadcast designation information. Sahota provides an end-to-end framework for network operators and broadcasters to integrate seamlessly existing assets to generate new interactive advertising services (Sahota: paragraph 0062).

The Applicant further notes, that it is not understood how paragraph 0061 of Sahota teaches what is recited in claim 1 which is required of an anticipatory reference.

The Examiner notes, paragraph 0061 was cited and its relevance explained as set forth above. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

The Applicant further argues that nothing in Sahota suggests “commercial message broadcast designation information” is received “at a broadcast reception terminal.”

The Examiner disagrees, Sahota discloses a TV **104** that has the capability of displaying broadcast designation information. This is clearly illustrated in Fig. 1A.

The Examiner further notes, even though the specific claimed information is anticipated by the prior art, said information is not functionally interrelated to the broadcast reception terminal. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MSG
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